

Appl. No. : 09/457,207
Filed : December 7, 1999

REMARKS

Claims 1, 3-5, 8 and 11 are pending in the application and are presented for reconsideration and further examination. By the foregoing amendments, Claim 1 has been amended.

Rejections under 35 U.S.C. § 112

In the Office Action, Claim 1 was rejected under 35 U.S.C. § 112, ¶ 2, as being indefinite. Claim 1 has been amended to address the antecedent basis issue pointed out in the Office Action. Applicant respectfully requests that the rejection under § 112 be withdrawn.

Rejections under 35 U.S.C. § 103

In the Office Action, all of the pending claims were rejected under 35 U.S.C. § 103(a) as being unpatentable over Rahamim (U.S. Patent No. 5,764,694). Applicant respectfully traverses this rejection. Though the following remarks focus on the independent claims, they apply with equal force to each of the rejected claims.

Rahamim describes a system which enables "a modem to perform the functions of a self-test in a measurement system such that the modem itself can report absolute levels of noise, distortion and echo, each individually." (Rahamim, col. 4, lines 10-13, emphasis added). Figure 1 of Rahamim depicts a modem 110 being tested and a host computer 112. Rahamim does not teach or suggest a separate device which is used to test a modem.

Claim 1 is directed to the device which is used to test a modem which is inside a computer. The rejection of claim 1 in view of the system depicted in Figure 1 of Rahamim is improper because the rejection relies upon a combination of the elements within the modem 110 under test and the host computer 112. The system of Rahamim only includes 1) a host computer 112 and 2) a modem 110 which is being tested. That is unlike the system of the present application which includes 1) a device for testing a modem (claim 1) and 2) a modem inside 3) a computer. It is illogical to suppose that the modem under test itself can provide elements of the claimed device for testing the operation of a modem.

Specifically, with regard to the rejection of Claim 1, the Office Action asserts that Rahamim teaches a device for testing the operation of a modem in a computer. The rejection goes on to state that a case is inherent. However, the rejection then goes on to identify elements

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within both the host computer and the modem under test to meet the limitations of the claim. It is certainly not inherent to encase a modem under test in a test device. In fact, such a combination is illogical and impractical. Such a combination would require that the case be disassembled to insert and remove the modem being tested.

Continuing on with the rejection, the rejection states that the limitation of the first communication port is met by the transmit signal between 112 and 140 in Figure 1 of Rahamim. The rejection goes on to state that the limitation of the second communication port is met by the RX signal running between elements 140 and 118. Elements 140 and 118 are both elements of the modem under test. It is not logical to assert that the modem under test itself can provide elements of the claimed device which tests the modem. In addition, in no way does the signal between elements 140 and 118 show a communication port which is configured to be coupled with the computer. In Figure 1 of Rahamim, the computer is element 112.

With regard to independent claim 5, that claim is also rejected as being obvious in view of Rahamim. Claim 5 is directed to a method of testing the operation of a modem in a computer using a portable modem testing device. Again, as was mentioned above in connection with claim 1, Rahamim does not teach or disclose 1) a testing device, 2) a modem and a 3) computer. Rather, Rahamim teaches merely 1) a modem which performs a self test function which works in cooperation with 2) a host computer.

More specifically, the rejection of claim 5 points to element 140 of Figure 1 as being the modem in the computer. However, element 140 is not a modem. Element 140 is merely a piece of the modem, specifically the micro controller. The modem is clearly identified in the specification as Item 110. (Rahamim, col. 4, line 28.)

The rejection then goes on to identify the "modem testing device" as elements 118, 120 and 132 of Figure 1 of Rahamim. Again, all of those numbered elements are sub-parts of the modem 110. Specifically, 118 is the data pump, 120 is the analog interface and 132 is the data access arrangement which handles the telephone line. (Rahamim, col. 4, lines 28-34.) They are not part of a testing device.

For the limitations of "coupling the modem in the computer to the portable modem testing device", the rejection points to connections between the modem micro controller 140, apparently representing the modem, and elements 118, 120 and 132, apparently representing the

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modem testing device. However, as been noted previously elements, 118, 120 and 132 are parts of the modem itself and are not part of a modem testing device.

For the limitation of coupling the computer to the portable modem testing device by an alternate communication link, the Office Action points to SIGNAL CONT. SIG. However, that signal runs from computer 112 to micro controller 140. In the previous sentence of the rejection micro controller 140 was identified as the modem. The rejection cannot properly point to an item as being the modem under test in one section of the rejection and then point that same item as being the testing device in a later section of the rejection.

Similarly, the rejections of independent claim; 8 and 11 appear to mislabel and misidentify the elements of Rahamim in order to line them up with the elements of the claims. This is an improper interpretation of Rahamim and cannot serve as the basis of a proper rejection.

In view of the foregoing, Applicant respectfully requests that the rejections be withdrawn.

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CONCLUSION

The Applicant has endeavored to address all of the Examiner's concerns as expressed in the outstanding Office Action. Accordingly, amendments to the claims, the reasons therefor, and arguments in support of the patentability of the pending claim set are presented above. Any claim amendments which are not specifically discussed in the above remarks are made in order to improve the clarity of claim language, to correct grammatical mistakes or ambiguities, and to otherwise improve the capacity of the claims to particularly and distinctly point out the invention to those of skill in the art. In light of the above amendments and remarks, reconsideration and withdrawal of the outstanding rejections is specifically requested. If the Examiner finds any remaining impediment to the prompt allowance of these claims that could be clarified with a telephone conference, the Examiner is respectfully requested to initiate the same with the undersigned.

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

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